

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Edward J. Stashluk, Jr. et al
U.S. Patent Serial No.: 10/697,485
Filing Date: October 30, 2003
Group No.: 3625
Examiner: Michael Misiaszek
Confirmation No. 7404
Title: MERCHANDISE RETURN SYSTEM WITH VALUE
ADDED RETURNS PROCESSING (DATA
COMMUNICATIONS)

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the rejection of all claims in the Application.

REMARKS

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action (the "Final Office Action") to establish a *prima facie* rejection of the claims in the Application under 35 U.S.C. § 103. The Final Office Action rejected Independent Claims 1 and 33 under 35 U.S.C. § 103 as allegedly being obvious over U.S. Patent No. 6,536,659 issued to Hauser et al. ("*Hauser*") in view of "Cattron Acquires Theimeg"; Modern Materials Handling; Boston; October 2000 ("*ReturnValet1*") and U.S. Patent Application Publication No. 2004/0172260 issued to Junger et al. ("*Junger*"). However, it is Applicants' position that these rejections of at least the independent claims fail to meet the required *prima facie* standard for rejections for the reasons set forth below.

The Proposed References Fail to Disclose Applicants' Claims

The Final Office Action relies upon *Hauser* for disclosure of Applicants' operational step of "receiving . . . packages containing returned items," upon *ReturnValet1* for disclosure of a plurality of regional return centers, and upon *Junger* for disclosure of carrier delivery. In the Response to Final Office Action submitted on February 28, 2007 (the "Response to Final Office Action"), Applicants contend that even when the cited portions of *Hauser*, *ReturnValet1*, and *Junger* are read together in the manner proposed by the Examiner, the references do not disclose "receiving, by carrier delivery, packages containing returned items at a selected one of the regional returns centers . . . wherein affixed to each package is a printed label, the label having machine readable data representing at least the identification of a merchant associated with the returned item, the printed label including a destination address associated with the selected one of the regional returns centers, the selected one of the regional returns centers selected for carrier delivery of the package because the selected one of the regional returns centers is geographically closer to a location of a customer from which the package is received than others of the plurality of regional returns centers," as recited in Claim 1. Certain analogous features and operations recited in independent Claim 33 are also not taught by the proposed *Hauser-ReturnValet1-Junger* combination.

Specifically, although *ReturnValet1* discloses a plurality postal centers to which products can be returned, *ReturnValet1* states that such postal centers are where "[the consumer] can go and return the product." (Page 1). The returned packages received at the

postal centers of *ReturnValet1* are not disclosed to have “a printed label” having the features recited in Claim 1. Although *Hauser* discloses a printed label,” *Hauser* only discloses a “NATIONAL RETURN CENTERTM” that is “a central return facility.” (Column 3, lines 59-63). Thus, *Hauser* also does not disclose “a printed label including a destination address associated with the selected one of the regional return centers, the selected one of the regional returns centers selected . . . because the selected one of the regional returns centers is geographically closer to a location of a customer . . . than others of the plurality of regional returns centers,” as recited in Claim 1. Although *Junger* discloses carrier delivery, generally, *Junger* also does not disclose the recited features (and has not been cited by the Examiner as doing such). For at least these reasons and for the reasons more fully described on pages 9-10 of the Response to Final Office Action, Applicants respectfully submit that the proposed combination of references does not disclose, teach, or suggest the particular combination of features recited in Applicants’ Claim 1. In fact, the rejection of Claim 1 over the proposed *Hauser-ReturnValet1-Junger* combination, in the manner provided by the Examiner, can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicants’ claims.

For at least these reasons, Applicants request that the rejection of independent Claims 1 and 33 and their dependents (including Claims 3-6 and 34-46, respectively) be withdrawn.

The Proposed Combinations of References is Improper

Additionally, it has been and continues to be Applicants’ position that the proposed *Hauser-ReturnValet1-Junger* and *Hauser-ReturnValet1-Junger-ReturnValet2* combinations are improper. In the Response to Final Office Action, Applicants discussed in great detail the stringent standard required for combining and modifying references. Applicants’ discussion is described on pages 11-13 of the Response to Final Office Action. Applicants also noted the Federal Circuit’s finding that “[i]t is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention.” *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). It continues to be Applicants’ position that the objectives of the respective systems of *Hauser* and *Junger* do not provide a suggestion to combine these references in the manner suggested by the Examiner.

The very principle and purpose of the system disclosed in *Junger* is the provision of a return system between two intermediary sources of a product. Specifically, *Junger* provides

a system and method that allows a retailer to obtain batch reimbursement from a manufacturer. With respect to the customer, *Junger* only discloses that a return is accepted “[w]hen a customer returns a product with a receipt,” “the serial numbers match,” and “all other return conditions are met.” (Column 2, lines 14-18). However, *Junger* assumes that this transaction occurs prior to the receipt of the returned items for processing using the return system of *Junger*. In *Junger*, it is the merchant (or retailer) who is being reimbursed by the manufacturer.

Conversely, *Hauser* provides customers of merchants “with a return authorization shipping label” that can then be used to return merchandise to a “central return facility.” (Abstract). According to *Hauser*, “a return label is provided to the customer for inclusion with the merchandise being returned.” (Column 2, lines 16-19). The customer then “ships the merchandise being returned to the return facility.” Thus, while the objective of *Junger* is to provide for the processing of retailer returns on a batch-by-batch basis in a retailer-manufacturer context, the objective of *Hauser* is to provide for the processing of customer returns on an item-by-item basis in a retailer-customer context. As a result, the solution proposed in *Junger* is drastically different from the solution proposed in *Hauser*, and one of ordinary skill in the art at the time of invention would not have been motivated to combine the disclosure of *Junger* with the disclosure of *Hauser*. The inconsistencies in *Junger* and *Hauser*, as identified by Applicants, evidences the Examiners reconstruction of Applicants’ claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references. Accordingly, Applicants respectfully submit that the Examiner’s conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

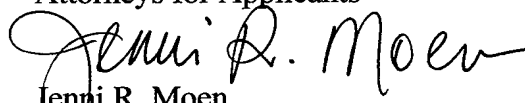
The Examiner's Rebuttal to Applicants' Arguments in the Advisory Action

In an Advisory Action mailed on March 19, 2007 ("Advisory Action"), the Examiner addressed Applicants' remarks only by rebutting Applicants' contention that the proposed combinations of references is improper. The Examiner does not address Applicants' arguments with regard to the failure of the references to teach Applicants' claim elements. The M.P.E.P. provides that "[w]here the applicant traverses any rejection, the examiner should if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (M.P.E.P. § 707.07(f)). In this instance, Applicants submit that the Examiner has failed to respond to Applicants' arguments disputing that the proposed *Hauser-ReturnValet1-Junger* combination discloses, teaches, or suggest Applicants' steps of "receiving an SQL input" and "transforming a hierarchical data store into relational database tables based on the received SQL input."

CONCLUSION

As the rejections of Claims 1, 3-6, and 33-46 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1, 3-6, and 33-46. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,
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